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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/317,303	05/24/1999	BRUCE A. DONOHO	DONO-7	8945

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EXAMINER

PALO, FRANCIS T

ART UNIT PAPER NUMBER

3644

DATE MAILED: 02/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/317,303

Applicant(s)

DONOHO, BRUCE A.

Examiner

Francis T. Palo

Art Unit

3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 10-18 and 20-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 10-18 and 20-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 March 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Continued Prosecution Application*

The Request for Continued Examination (RCE) filed 1/19/06 under 37 CFR 1.114 based on parent Application No. 09/317,303 is acceptable, and an RCE has been established. An action on the RCE follows.

### *Response to Arguments*

Applicant's arguments, see amendment, filed 1/19/06, with respect to the drawing and claim objections raised in the office action mailed 10/20/05 have been fully considered and are persuasive. The drawing objections have been withdrawn and the claim objections are rendered moot by the claim(s) amendments.

The broader new independent claim-35 is acknowledged.

### *Drawings*

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims.

Therefore, **the deterrent (without upwardly extending intermediate prongs)** as recited in new claim-35 must be shown, **and the intermediate prongs having a first and second portion further having a round cross-section** must also be shown as claimed in claim-26. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because reference characters "**22**" and "**14**" (**figure-2**) have both been used to designate the **upwardly extending intermediate prongs (22)**.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended.

Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Claim Objections***

**Claim-29** is objected to because of the following informalities:

The claim language "upwardly prongs" is awkward and should be amended.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 13-15** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The use of "about" in the claims is indefinite and not clear, the term should be deleted or changed as utilized in the new claim-35 (i.e.; 'not more than').

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 10-12, 16-18, 20 and 22-34** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over Richardson (GB 2344269A) 3/12/1998,  
in view of Shaw (US 3,282,000) 1963.

Regarding **claim-10**:

Applicant submits in section-III on page-8 of the response filed 1/19/06, that Richardson '269A is silent as to upwardly extending intermediate prongs (i.e. 90° relative to the rail) as claimed in the instant invention. Applicant further points out that Shaw '(000) teaches an intermediate upwardly extending prong.

The Examiner submits that Richardson provides motivation for a five-rayed deterrent, and Shaw '000 is relied upon for the teaching of an upwardly extending intermediate prong, while Burnside '171 teaches variously angled prongs and Peles '243 provides the motivation for a prong cross-shape cross-section.

Specifically, Richardson teaches in the Abstract a “**deterrent device comprising a base of plastics material moulded integrally with a plurality of plastics material prongs extending at at least four different angles to the base element”.**

Richardson therefore, provides the motivation for **more than four different angles to the base element**, as claimed in the instant invention; and Shaw '000 provides the teaching for upwardly extending intermediate prongs (figure-7) of plastic construction.

As Richardson teaches an integrally moulded four-rayed plastics construction and further provides the motivation for at least a five-rayed configuration, the Examiner submits that Richardson as modified by Shaw, renders obvious the invention of the instant claim, and therefore;

It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include an upwardly extending intermediate prong as taught by Shaw, for the known advantages of that feature.

Furthermore, it has been held that forming in one piece an article which has formerly been formed in two pieces and put together involves only routine skill in the art, (*Howard v. Detroit Stove Works*, 150 U.S. 164 (1893); for instance).

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In conclusion, the Examiner appreciates the comments submitted in section-III of the response filed 1/19/06, particularly in the last paragraph; however, the Examiner is not convinced that a five-rayed unitary construction as submitted, is novel, and the Applicant is reminded that the instant invention is directed to an apparatus and not to a method of manufacture as argued.

Regarding **claim-11**:

The discussion above regarding claim-10 is relied upon.

The limitations of the instant claim are readily apparent from figure-1 of Richardson.

Regarding **claim-12**:

The discussion above regarding claim-11 is relied upon.

Richardson as modified by Shaw is readable on the instant claim, as Richardson teaches angles less than 90°.

Regarding **claims 16 and 17**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts a base readable as a rail and side projections extending from the base (rail) continuous with the rail, as claimed.



Regarding **claim-18**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches prongs extending upwards from side projections extending laterally from the main path of the strip-like base element at line-15 (thereabout) on page-3.

Regarding **claims 20 and 22**:

The discussion above regarding claim-10 is relied upon.

Prongs as claimed, are readily apparent from figure-1 of Richardson.

Regarding **claims 23 and 24**:

The discussion above regarding claim-10 is relied upon.

Richardson teaches (depicts) a base (read as a rail) having a flat bottom surface and a trough; the trough located on the upper surface of the base.

Note: it is not clear from the claim language which side the trough is located.

Regarding **claim-25**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts in figure-1 structure(s) readable on a ridge, as claimed.

Regarding **claim-26**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts a tapered spike readable as having first and second portions having a round cross-section; Richardson as modified by Shaw is readable therefore thereon the instant claim.

Regarding **claim-27**:

The discussion above regarding claim-10 is relied upon.

Richardson as modified by Shaw renders a five-fanned projection as claimed.

Regarding **claim-28**:

The discussion above regarding claim-10 is relied upon.

Richardson as modified by Shaw renders a normal extending prong as claimed.

Regarding **claim-29**:

The discussion above regarding claim-10 is relied upon.

As discussed above in the rejection of claim-28, Richardson as modified by Shaw renders a normal extending prong as claimed, and while Richardson teaches ridges running along the upper surface of the rail (base), Richardson is silent as to upwardly extending prongs being normal to a ridge running along an upper surface of the rail.

Shaw teaches normal prong extension from a ridge as depicted in figures 4 and 7.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include an upwardly extending intermediate prong as taught by Shaw and as claimed, for the known advantages of that feature.

Regarding **claim-30**:

The discussion above regarding claim-10 is relied upon.

Richardson depicts cutting notches on the underside of the base (rail) as claimed.

Regarding **independent claim-31**:

The discussion above regarding independent claim-10 is relied upon as encompassing the instant claim.

Regarding **claims 32-34**:

The discussion above regarding claim-31 is relied upon.

The structure and orientation of the prongs as claimed are readily apparent from the depictions of Richardson.

**Claims 13-15** are rejected under 35 U.S.C. 103(a),  
as being unpatentable over Richardson and Shaw,  
as applied to claims 10 and 11 above,  
and further in view of Burnside (US 2,777,171) 1951.

**Regarding claims 13-15:**

The discussions above regarding claims 10 and 11 are relied upon.

Richardson teaches prong angles on the order of 60 and 82° to the underlying base (page-4, lines 25 and 36) and therefore on the order of 22° difference between the prongs; Richardson does not teach about 30 and 70° and a difference of about 40°, as claimed.

Richardson in column-4 at lines 18 and 24 (thereabout) recites, "in this example the angles"; the language is read as motivation for other angles to be utilized other than discussed and depicted in the teaching.

Burnside teaches prongs (11-15) "bent upwards at different angles..", (column-3, lines 22-23) and prongs (21-25), "bent at somewhat different angles than those of figure-1", (column-3, lines 28-29).

The Examiner submits that Burnside teaches the angles claimed in the instant claims, or at least the obviousness for that capability, that is; prong angles of about 30 and 70° are apparent from the figures 1 and 2 of Burnside.

It would have been obvious therefore to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, and depicted and inferred by Burnside, for the known advantages of that feature.

**Claim-21** is rejected under 35 U.S.C. 103(a) as being unpatentable over Richardson and Shaw as applied to claim-10 above, and further in view of Peles (US 2,938,243) 1953.

Regarding **claim-21**:

The discussion above regarding claim-10 is relied upon.

Richardson is silent as to prong cross-section configuration except for the depictions, which resemble tapered prongs having circular cross-sections.

Peles '243 teaches a prong readable on a cross-shaped cross-section (at a minimum a partial cross-shaped cross-section) to provide rigidity to the prongs (column-2, lines 20-22).

As it has been held that mere duplication of essential working parts of a device requires only routine skill in the art (*In re Japikse*, 86 USPQ 70), it would have been obvious to reproduce the ridge (21) on the other side of the Peles prong for the known advantage of that feature, which would enable the full cross-shaped cross section as claimed.

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Therefore, It would have been obvious to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong cross-section as claimed as taught by Peles, for the known advantage of that feature as taught by Peles.

**Claim-35** is rejected under 35 U.S.C. 103(a),  
as being unpatentable over Richardson in view of Burnside.

Regarding **new independent claim-35**:

Richardson as discussed above in the rejection of claim-10 teaches an integrally moulded deterrent as claimed, and teaches prong angles on the order of 60 and 82° to the underlying base (page-4, lines 25 and 36); Richardson does not specifically recite no more than 70°, as claimed.

Burnside as discussed above in the rejection of claims 13-15 provides the teaching for various angles, which would encompass the claimed 70° prong angle.

It would have been obvious therefore to one of ordinary skill in the art at the time the invention was made, to have modified the deterrent of Richardson to include the prong angles as claimed, and as depicted and inferred by Burnside, for the known advantages of that feature.

### ***Conclusion***

In summation, Richardson (1998) teaches an integrally moulded bird deterrent having alternating pairs of prongs, and further provides the motivation for more than four prongs. Shaw (1963) provides the teaching of an intermediate prong normal to the underlying base, Burnside (1951) teaches the obviousness of various prong angles, and Peles (1953) provides the teaching of a cross-shaped cross-section as claimed in the instant invention.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bittner '730 teaches prongs having round cross-sections.

Peles '803 teaches a cross-shaped cross-section in a deterrent prong (figure-9).

Miskimins '555 teaches a prong having circular and cross-shaped cross-sections.

Peles '047 teaches a base member having a longitudinal ridge supporting a prong normal to the base.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Francis T. Palo whose telephone number is 571-272-6907. The examiner can normally be reached on M-Tu.,Th.-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*Francis T. Palo*  
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Art Unit 3644